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PTOL-90A (Rev. 10/06)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/641,021
Filing Date: August 17, 2000
Appellant(s): CAYTON ET AL.

MAILED

APR **1 8** 2007

GROUP 3600

Jody C. Bishop
Reg. No. 44,034
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/2/2006 appealing from the Office action

mailed 1/19/2006 and the order return from BPAI sent 4/2/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Williams et al. (US 6,618,734 B1), September 9, 2003

Smith (US 6,701,313 B1), March 2, 2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

   form the basis for the rejections under this section made in this Office action:

   > A person shall be entitled to a patent unless -
   >
   > (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-2, 6-26, 28-34, and 36-44, 46-76, and 78-87 are rejected under 35**

   U.S.C. 102(e) as being anticipated by Williams et al. (US 6,618,734 B1).

3. As per **independent Claim 1, Williams** discloses a method for qualifying

   candidates for employment with an employer (abstract), said method comprising:

   executing a computer program, said computer program receiving as input from

said employer a desired hiring criteria of said employer (C3 L30-64); based on said desired hiring criteria of said employer, said computer program generating at least one customized application program (automated interview questions) that is executable to interact with candidates for employment with said employer and determine whether each of said candidates is qualified for employment with said employer (C3 L2-5, C3 L62-64); allowing said candidates access to the at least one generated customized application program (C5 L48-67); and responsive to input from each of said candidates to the at least one generated customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer (C5 L53-67).

4. **As per independent Claims 30, 54, and 62,** Williams discloses a system (computer executable program code, or business method) for use in qualifying candidates for employment with an employer (abstract), said system (computer executable program code, or business method) comprising: a processor-based device; and a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program (C3 L2-5, C3 L30-64), wherein said desired hiring criteria specifies at least one attribute to be possessed by a candidate to be considered qualified for a position of employment (C2 L58-62, C10 L49-58), and wherein said at least one application program is executable to interact with candidates and determine whether each of said candidates qualifies for said position of employment with said employer (C5 L48-67).

5. As per Claim 2, Williams discloses wherein said desired hiring criteria includes at least one criteria selected from the group consisting of: candidate's education, candidate's work experience, candidate's possessing a particular license, candidate's language skills, and candidate's computer skills (C2 L50-62).

6. As per Claim 6, Williams discloses wherein said computer program receiving said desired hiring criteria further includes: receiving said desired hiring criteria from a user interface (C3 L30-36 job profiling obtained and *entered into the system*, user interface inherent).

7. As per Claim 7, Williams discloses wherein said user interface is a separate program executable to communicative with said computer program (C3 L30-64, job profiling interview design system communicates with candidate interview application).

8. As per Claims 8, 36, and 57, Williams discloses wherein said at least one customized application program is executable to interact with a candidate to enable said candidate to self-administer a qualification session for a position of employment with said employer (Fig.2-6).

9. As per Claims 9, 37, and 58, Williams discloses wherein said at least one customized application program enables access by one or more candidates via at least one communication platform (Fig.2-6, C2 L50-54).

10. As per Claims 10, 38, and 59, Williams discloses wherein said at least one communication platform includes platforms selected from the group consisting of

telephony-based platform, web-based platform, and other processor-based platforms (Fig.2-6, C2 L50-54).

11. As per Claims 11, 39, and 60, Williams discloses an IVR application that enables access by one or more candidates via telephone (Fig.2-6, C2 L50-54).

12. As per Claims 12, 40, and 61, Williams discloses wherein said at least one customized application program includes a web-based application that enables access by one or more candidates via a processor-based device via the World Wide Web (C2 L50-54).

13. As per Claims 13 and 41, Williams discloses wherein said generating step includes: generating a plurality of said customized application programs (abstract, system generated for *all published job openings*).

14. As per Claims 14 and 42, Williams discloses wherein each of said plurality of customized application programs is executable to enable interaction with candidates via different communication platforms (C2 L50-54, candidate information collected by the system of the present invention via the use of various media including but not limited to IVR telephone technology, CD Rom, and Internet based interactive response platforms).

15. As per Claim 15, Williams discloses said computer program receiving as input from said employer preferences of said employer as to characteristics of said at least one customized application program (C2 L50-62, client identified dimensions).

16. As per Claim 16, Williams discloses wherein said computer program receives as input from said employer indication of one or more communication platforms on which said at least one customized application program is to enable access by candidates (C6 L34-36, client pre-determines response mode).

17. As per Claims 17 and 67, Williams discloses wherein said at least one customized application program is executable to assist in further screening of candidates beyond determining whether based on said desired hiring criteria said candidates qualify for a position of employment with the employer (C8 L41-61, background check and facilitating interview).

18. As per Claims 18 and 68, Williams discloses wherein said at least one customized application program is executable to schedule future testing with a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer (C8 L41-61, facilitating follow-up interview).

19. As per Claims 19 and 69, Williams discloses wherein said at least one customized application program is executable to administer testing of a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer (C8 L11-41, BAI analysis).

20. As per Claims 20 and 70, Williams discloses wherein said at least one customized application program is executable to schedule a future personal interview with hiring personnel of the employer and a candidate determined

based on said desired hiring criteria to be qualified for a position of employment

with the employer (C8 L51-67, C9 L1-23).

21. As per Claims 21 and 71, Williams discloses wherein at least one customized

application program interacts with a calendaring program to schedule said future

personal interview at a time available for said hiring personnel (C9 L1-5,

automated scheduler)

22. As per Claims 22 and 72, Williams discloses wherein said at least one

customized application program is executable to forward supplemental materials

to hiring personnel of the employer for a candidate determined based on said

desired hiring criteria to be qualified for a position of employment with the

employer (C8 L45-61, send interview results or background checks).

23. As per Claims 23, 44, and 73, Williams discloses wherein said supplemental

materials include at least one of the materials selected from the group consisting

of candidate resume, writing sample, *questionnaire*, letter of recommendation,

and school transcript (C8 L45-61, send interview results – BFOQ and BAI).

24. As per Claims 24 and 74, Williams discloses wherein said at least one

customized application is executable to forward said supplemental materials to

hiring personnel electronically (C8 L45-61, send interview results or background

checks)

25. As per Claims 25, 47, and 75, Williams discloses wherein said at least one

customized application is executable to forward said supplemental materials to

hiring personnel via at least one communication method selected from the group

consisting of e-mail and fax (C8 L45-61, send interview results or background

checks; C9 L19-23, application for employment transmitted to HR)

26. As per Claims 26 and 76, Williams discloses the step of said at least one

    customized application receiving said supplemental materials from a candidate

    (C9 L19-23, application for employment transmitted to HR).

27. As per Claim 28, Williams discloses the step of said at least one customized

    application program outputting to a candidate determined by said customized

    application program as not qualifying for a position of employment with the

    employer one or more reasons for said candidate not qualifying (C8 L35-38).

28. As per Claim 29, Williams discloses the step of storing to a database, information

    about a candidate received by said at least one customized application (C6 L52-

    54, candidate account in the system).

29. As per Claim 31, Williams discloses wherein said processor-based device is a

    device selected from the group consisting of PC, workstation, laptop computer,

    and PDA (C1 L6-20).

30. As per Claim 32, Williams discloses wherein said processor-based device is a

    server computer (C1 L6-20, Internet related system).

31. As per Claim 33, Williams discloses wherein said server computer comprises a

    web server (C1 L6-20, Internet related system).

32. As per Claim 34, Williams discloses wherein said at least one attribute includes

    an attribute concerning one selected from the group consisting of: candidate's

education, candidate's work experience, candidate's possessing a particular

license, candidate's language skills, and candidate's computer skills (C2 L50-62).

33. As per Claim 43, Williams discloses an input device communicatively coupled to

said processor-based device to enable candidates to input supplemental

materials to said processor-based device (C9 L19-23, application for

employment).

34. As per Claim 46, Williams discloses wherein said at least one application

program is executable to electronically communicate said supplemental materials

to hiring personnel (C9 L19-23, transmitted to HR).

35. As per Claim 48, Williams discloses a data storage device communicatively

coupled to said processor-based device to enable storage of data received by

said at least one application program (C1 L6-20, C2 L50-53).

36. As per Claim 49, Williams discloses wherein said data storage device is at least

one device selected from the group consisting of hard drive, floppy disk,

Compact Disc (CD), Digital Versatile Disc (DVD), and other data storage devices

(C1 L6-20, C2 L50-53).

37. As per Claims 50, 52, 63, and 65, Williams discloses wherein said processor-

based device is communicatively coupled to a communication network to enable

access by said employer / candidates to said computer program via said

communication network (C2 L50-53, C3 L25-27, Internet).

38. As per Claims 51, 53, 64, and 66, Williams discloses wherein said

communication network is a network selected from the group consisting of:

PSTN, wireless communication network, a proprietary network, general purpose

processor-based information network, dedicated communication lines, computer

network, direct PC to PC connection, LAN, WAN, modem to modem connection,

Internet, Intranet, Extranet, or any combination thereof (C2 L50-53, C3 L25-27,

Internet).

39. As per Claim 55, Williams discloses wherein said code for presenting and code

for generating are part of a common computer program (C1 L6-20, inherent to

PC system/application operation).

40. As per Claim 56, Williams discloses wherein said code for presenting and said

code for generating are each part of separate computer programs that are

capable of communicating with each other (C1 L6-20, inherent to PC

system/application operation; example: automated interview system

communicates with automated interview scheduler).

41. As per Claims 78, 83, 85, and 87, Williams discloses wherein said input of

employer preferences as to characteristics of said at least on customized

application program received by said computer program includes at least one

selected from the group consisting of: input indicating whether the at least one

customized application program is to automatically schedule an interview with

candidates determined to be qualified for a position (C8 L41-67), input indicating

whether the at least one customized application program is to interact with a

calendaring program to schedule an interview with candidates determined to be

qualified for a position (C9 L1-11, automatic scheduler), input indicating one or

more interviewers with whom an interview is to be schedules for candidates determined to be qualified for a position (C9 L1-11, automatic scheduler), input indicating whether the at least on customized application program is to request supplemental material from candidates determined to be qualified for a position (C9 L19-23, application for employment), input indicating whether the at least one customized application program is to forward supplemental material received from qualified candidates to one or more hiring managers (C9 L19-23, transmitted to HR), and input indicating whether the at least one customized application program is to schedule future testing (interview) with a candidate determined to be qualified for a position (C8 L41-67).

42. As per Claim 79, Williams discloses wherein said generated at least one customized application program operates in accordance with the input employer preferences (C8 L54-57, client selections option for follow-up interview).

43. As per Claim 80, Williams discloses wherein said supplemental material includes at least one of the materials selected from the group consisting of: candidate resume, writing sample, *questionnaire*, letter of recommendation, and school transcript (C9 L19-23, application for employment – equivalent to questionnaire).

44. As per Claims 81 and 86, Williams discloses wherein said computer program is further executable to receive as input preferences of said employer as to operational characteristics of said at least one application program to be generated (C2 L60-62, C3 L62-64).

45. As per Claims 82 and 84, Williams discloses wherein said computer program is

operable to receive a preference of said employer as to one or more

communication platforms in which said at least one application program is to

enable access by candidates (C6 L34-36).

Claim Rejections - 35 USC § 103

46. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

47. **Claims 3-5, 35, and 88-92 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Williams in view of Smith (US 6,701,313 B1).

48. As per Claim 3, although Williams discloses wherein said computer program

provides hiring criteria for said employer as said desired hiring criteria (C2 L50-

62, 1st tier eligibility requirements; C7 L52-55).

49. Williams fails to expressly discloses wherein said computer program provides a

predetermined list of hiring criteria for selection by said employer as said desired

hiring criteria.

50. Smith discloses a computer program in a employment decision system, which

provides a predetermined list of hiring criteria (lists boxes) for selection by said

employer as said desired hiring criteria (C7 19-56, C8 L28-40)

51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said computer program provides a predetermined list of hiring criteria for selection by said employer as said desired hiring criteria, as disclosed by Smith in the system disclosed by Williams, for the advantage of providing a method for qualifying candidates for employment with an employer, with the ability to increase system effectiveness/efficiency by allowing the using to enter job criteria in a number of formats (enter free text / select from list).

52. As per Claim 4, Williams fails to expressly discloses wherein said computer program allows said employer to input additional hiring criteria not included on said predetermined list.

53. Smith discloses a computer program in an employment decision system, which allows said employer to input additional hiring criteria (create test questions) not included on said predetermined list (C13 L8-35, job provider writes questions and saves to question database).

54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said computer program allows said employer to input additional hiring criteria not included on said predetermined list, as disclosed by Smith in the system disclosed by Williams, for the advantage of providing a method for qualifying candidates for employment with an employer, with the ability to increase system effectiveness/efficiency by

allowing the using to enter job criteria in a number of formats (free text / select from list).

55. As per Claims 5 and 35, Williams discloses the ability of employers to enter changes into the system (C2 L35-41, system accepts changes to employment criteria); Williams fails to expressly disclose wherein said computer program includes a user interface for interacting with said employer to receive as input said desired hiring criteria from said employer.

56. Smith discloses wherein said computer program includes a user interface for interacting with said employer to receive as input said desired hiring criteria from said employer (Fig.1 and Fig.6).

57. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said computer program includes a user interface for interacting with said employer to receive as input said desired hiring criteria from said employer, as disclosed by Smith in the system disclosed by Williams, for the advantage of providing a method for qualifying candidates for employment with an employer, with the ability to increase system effectiveness/efficiency by providing tools to the user for direct communication with the system.

58. As per Claims 88 and 92, Williams fails to expressly disclose wherein said computer program receiving as input a desired hiring criteria comprises receiving manually inputted hiring criteria from said employer, and wherein said computer program generating said at least one customized application program comprises

said computer program automatically integrating the manually inputted hiring

criteria into the at least one customized application program.

59. Smith discloses a computer program in an employment decision system, which

receives manually inputted hiring criteria from said employer (C13 L8-35, job

provider writes questions and saves to question database), and wherein said

computer program generating said at least one customized application program

comprises said computer program automatically integrating the manually inputted

hiring criteria into the at least one customized application program (test creation

C12-C15 from question database).

60. Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have included wherein said computer program

receiving as input a desired hiring criteria comprises receiving manually inputted

hiring criteria from said employer, and wherein said computer program

generating said at least one customized application program comprises said

computer program automatically integrating the manually inputted hiring criteria

into the at least one customized application program, as disclosed by Smith in

the system disclosed by Williams, for the advantage of providing a method for

qualifying candidates for employment with an employer, with the ability to

increase system effectiveness/efficiency by allowing the using to enter job criteria

in a number of formats (free text / select from list).

61. As per Claims 89, 90, and 91, Williams fails to expressly disclose wherein said

computer program receiving as input a desired hiring criteria comprises:

receiving said input defining any hiring criteria desired for said position of

employment, wherein said input desired hiring criteria is not limited to a selection

of hiring criteria pre-defined by said computer program.

62. Smith discloses a computer program in an employment decision system, which

receives input defining any hiring criteria desired for said position of employment,

wherein said input desired hiring criteria is not limited to a selection of hiring

criteria pre-defined by said computer program (C13 L8-35, job provider writes

questions and saves to question database).

63. Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have included wherein said computer program

receiving as input a desired hiring criteria comprises: receiving said input defining

any hiring criteria desired for said position of employment, wherein said input

desired hiring criteria is not limited to a selection of hiring criteria pre-defined by

said computer program, as disclosed by Smith in the system disclosed by

Williams, for the advantage of providing a method for qualifying candidates for

employment with an employer, with the ability to increase system

effectiveness/efficiency by allowing the using to enter job criteria in a number of

formats (free text / select from list).

64. **Claim 27, 45, and 77 is rejected under 35 U.S.C. 103 as being unpatentable**

over Williams.

65. As per Claim 27, 45, and 77, Williams does not expressly show wherein said at

    least one customized application receives said supplemental materials via at

    least one of the following methods: fax, e-mail, and digital imaging device.

66. However these differences are only found in the nonfunctional descriptive data

    and are not functionally involved in the steps recited. The method/system for

    qualifying candidates for employment with an employer would be performed

    regardless of the how the supplemental materials were sent. Thus, this

    descriptive data will not distinguish the claimed invention from the prior art in

    terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,

    404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir.

    1994).

67. Therefore, it would have been obvious to one of ordinary skill in the art at the

    time the invention was made to have sent supplemental materials by fax, e-mail,

    and/or digital imaging device, because such data does not functionally relate to

    the steps in the method claimed and because the subjective interpretation of the

    data does not patentably distinguish the claimed invention.

(10) Response to Argument

1. The Appellant has argued the priority of the sited art of Williams et al. (US

   6,618,734 B1) through previous Declarations received 12/9/2004 and 4/6/2005.

2. However, the Declarations filed on 12/9/2004 and 4/6/2005 under 37 CFR 1.131

   have both been fully considered, but are ineffective for the priority date of

Williams et al. (7/20/2000).

3. The evidence submitted is insufficient to establish a conception of the invention

   prior to the effective date of the Williams's reference. While conception is the

   mental part of the inventive act, it must be capable of proof, such as by

   demonstrative evidence or by a complete disclosure to another. Conception is

   more than a vague idea of how to solve a problem. The requisite means

   themselves and their interaction must also be comprehended. See Mergenthaler

   v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

4. The Submitted evidence (Exhibit A) with the Declaration, which the Applicant

   relies on to overcome the Williams's reference, does not appear to satisfy

   conditions listed above. The Exhibit A is completely silent with regard to all the

   process steps recited in the independent claims; and is no more than a general

   overview of the claimed system.

5. Furthermore, the evidence submitted is insufficient to establish diligence from a

   date prior to the date of reduction to practice of the Williams's reference to either

   a constructive reduction to practice or an actual reduction to practice.

6. Where conception occurs prior to the date of the reference, but reduction to

   practice is afterward, it is not enough merely to allege that applicant had been

   diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 7333 (Comm'r Pat 1889).

   Rather, the applicant must show evidence of facts establishing diligence. The

   Applicant must account for the entire period during which diligence is required.

   Gould V. Schawlow, 363 F.2d 908, 919, 150 USPQ634, 643 (CCPA 1966). A 2-

day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542,

1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v.

Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month

of inactivity during critical period). Efforts to exploit an invention commercially do

not constitute diligence in reducing it to practice. An actual reduction to practice

in the case of a design for a three-dimensional article requires that it should be

embodied in some structure other than a mere drawing.); Kendall v. Searles, 173

F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that

applicants must be specific as to dates and facts.).

7. Therefore, so as the Declaration does not provide the sufficient evidence to

establish a conception of the invention prior to the effective date of the Williams's

reference, and does not show diligence from a date prior to the date of reduction

to practice of the Williams's reference to either a constructive reduction to

practice or an actual reduction to practice, the independent claims and claims

depending from them stand rejected as explained above.

8. As per Independent Claims 1, 30, 54, and 62, the Appellant has made the

argument that the sited prior art fails to teach or suggest a computer program

"generating at least one customized application program that is executable to

interact with candidates."

9. However, Williams discloses the generation of customized employment

systems/programs (Behavioral Assessment Interview) for each client/employer

(Fig.5-Fig.6, C8 L11-15). Furthermore, Williams discloses a detailed process of

determining the correct types of interview questions for each job/employer;

wherein, once determined, the questions are *entered into the system* (C3 L30-65,

not used by the employer for conducting an in-person interview), to be used by

the operating program in order to "generate" the finished customized employment

program (automated BFOQ assessment interview) used in the system/method.

10. As per Dependent Claims 6, 7, 13-16, 41, 42, 56, 78-80, 82-85, and 87, the

Appellant has made the arguments that the prior art fails to disclose the claimed

subject matter. However, the explanation of where and how Williams discloses

the claimed subject matter is explained in the rejection above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jonathan Ouellette

April 13, 2007
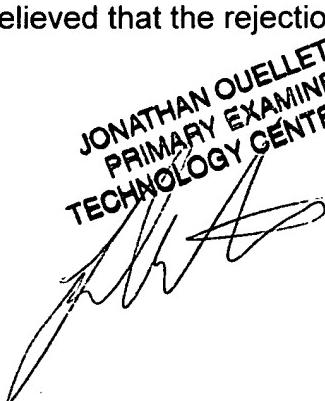
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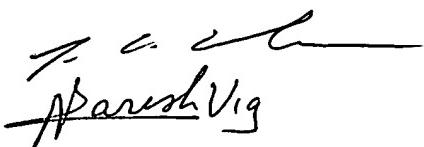
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